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S14-US1
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Susan LaMont
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In Re Application of:

WOLFFE and COLLINGWOOD

Serial No.: 09/844,508

Art Unit: 1645

Filing Date: April 27, 2001

Examiner: W. Sandals

Title: TARGETED MODIFICATION OF CHROMATIN STRUCTURE

TRANSMITTAL LETTER

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Transmitted herewith for filing is a Response to Requirement for Restriction mailed July 2, 2002. No fee is due.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 18-1648.

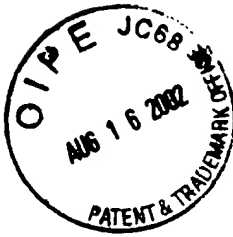
Respectfully submitted,

Date: August 2, 2002

By: D. Pasternak
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RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This is in response to the Restriction Requirement dated July 2, 2002 (Paper No. 11), for which a response is due on or before August 2, 2002. Accordingly, this response is timely filed. The Examiner therein required election of one of the following groups of claims:

Group I Claims, 1-4, 12-14, 17, 18 and 72, drawn to a method for modifying a region of cellular chromatin with a fusion molecule;

Group II Claims, 1 and 5-9, drawn to a method for modifying a region of cellular chromatin with a fusion polypeptide;

Group III Claims, 15 and 71, drawn to a method of expressing a fusion polypeptide;

Group IV Claims, 1, 10, 11 and 16, drawn to a method of identifying a fusion protein-binding region of chromatin;

Group V Claims, 1, 19 and 21, drawn to a method of modifying chromatin with a fusion molecule and a second molecule;

Group VI Claims, 1, 19, 20 and 22-26, drawn to a method of modifying chromatin with a fusion protein and a second molecule;

Group VII Claims, 1, 19, 27 and 29, drawn to a method of modifying chromatin with a fusion molecule, a second and third molecule;

Group VIII Claims, 1, 19, 27, 28 and 30-33, drawn to a method of modifying chromatin with a fusion molecule, a second and third molecule;

Group IX Claims, 34-39, drawn to a fusion protein;

Group X Claim, 40, drawn to a polynucleotide;

Group XI Claim, 41, drawn to a cell comprising of a fusion polypeptide;

Group XII Claim, 42, drawn to a cell comprising a polynucleotide;

Group XIII Claims, 43-45 drawn to a method of modulating expression with a fusion molecule and an expression modulatory molecule;

Group XIV Claims, 43 and 46-54, drawn to a method of modulation expression with a fusion protein and an expression modulatory molecule;

Group XV Claims, 43, 55, 56, 59, 60, 62, 64 and 66, drawn to a method of modulating expression with a fusion molecule and an expression regulatory molecule by binding to a plurality of chromatin sites;

Group XVI Claims, 43, 55, 57, 58, 61, 63, 65 and 67, drawn to a method of modulating expression of a fusion protein and an expression regulatory molecule by binding to a plurality of chromatin sites; and

Group XVII Claims, 1 and 68-70, drawn to a method of generating an accessible region of chromatin.

Applicants hereby elect to prosecute the claims of Group I (claims, 1-4, 12-14, 17, 18 and 72), **with traverse**. In support of the restriction requirement, the Examiner asserts that the claims of each group are mutually exclusive species. However, Groups I, II, IV, V, VI, VII, VIII and XVII all include claim 1; Groups V through VIII all include both claim 1 and claim 19; Groups XIII, XIV, XV, and XVI all include claim 43; and Groups XV and XVI include both claims 43 and 55. Therefore, Applicants request clarification as to how these claims are unrelated.

It is axiomatic that two criteria must be met for a proper restriction requirement under M.P.E.P. § 803: (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required.

Applicant respectfully submits that the Examiner has not met this burden. In particular, Groups I, II, IV, V, VI, VII, VIII and XVII are all classified in Class 435, subclass 6 in the U.S. Patent Classification System. Similarly, Groups XIII, XIV, XV, XVI are all classified in Class 435, subclass 69.1. Therefore, Groups I, II, IV, V, VI, VII, VIII and XVII and XIII, XIV, XV, XVI, respectively, are subject to all the same definitions, rules and, moreover, searches. Accordingly, they should be examined together and it would not constitute an undue burden for the Examiner to do so.

Furthermore, Applicants note that the M.P.E.P. clearly states that where the claims define the same essential characteristics of a single disclosed embodiment of an invention, varying in scope or breadth of definition of the same disclosed subject matter, a restriction requirement is improper. (see, M.P.E.P. 806.03). As discussed above, Groups XIII, XIV, XV, XVI define essentially the same subject matter as do Groups I, II, IV, V, VI, VII, VIII and XVII, **as evidenced by the identical classification**. Thus, applicants submit that the Restriction Requirement be redefined to combine Groups I, II, IV, V, VI, VII, VIII and XVII, drawn to methods for modifying a region of cellular chromatin, and to combine Groups XIII, XIV, XV, XVI, drawn to methods of modulating expression. As acknowledged by the Examiner, the search required for these Groups is the same. Therefore, examination of these Groups together would not only not place an undue burden on the Examiner, but would actually save the Examiner time.

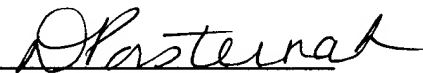
Applicants expressly reserve their right under 35 U.S.C. §121 to file one or more divisional applications directed to the nonelected subject matter during the pendency of this application. Further, should the Examiner make the requirement final, Applicants reserve the right to appeal.

In response to the species election requirements, Applicants elect VEGF of generic claim 18. It is to be understood that this election of species is for the purposes of preliminary search and examination only, and that upon allowance of a generic claim, applicants will be entitled to consideration of claims to the additional species.

The proposed groupings of the claims are confusing and any determination of distinctness or independence of the claimed invention(s) by the Examiner may have later ramifications during prosecution of this and related applications. For example, Applicants cannot understand what ramifications the proposed restriction requirement would have relative to double patenting issues during prosecution of the non-elected claims if they were filed and prosecuted in related applications (see, MPEP 806). **Further clarification is respectfully requested before the Examiner takes further action in this application. The Examiner is requested to review Applicants' traverse of the restriction requirement and to contact the Applicants.**

Respectfully submitted,

Date: August 2, 2002

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